

RECEIVED
CENTRAL FAX CENTER

FAX TRANSMISSION

MAR 24 2004

OFFICIAL

DATE: March 22, 2004

PTO IDENTIFIER: Application Number 10/030,793
Patent Number

Inventor: Victor Klimyuk et al.

MESSAGE TO: US Patent and Trademark Office

FAX NUMBER: (703) 872-9306

FROM: LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK, LLP
Shawn P. Foley

PHONE: (908) 518-6346

Attorney Dkt. #: ICON 3.3-002

PAGES (Including Cover Sheet): 7

CONTENTS: Certificate of Transmission under 37 CFR 1.8 (1 page)
International Preliminary Examination Report (5 pages).

Examiner Mehta:

Pursuant to our conversation, transmitted herewith is the IPER in connection with the corresponding PCT application. Your reconsideration of the Restriction Requirement would be greatly appreciated.

Shawn P. Foley

If your receipt of this transmission is in error, please notify this firm immediately by collect call to sender at (908) 518-6346 and send the original transmission to us by return mail at the address below.

This transmission is intended for the sole use of the individual and entity to whom it is addressed, and may contain information that is privileged, confidential and exempt from disclosure under applicable law. You are hereby notified that any dissemination, distribution or duplication of this transmission by someone other than the intended addressee or its designated agent is strictly prohibited.

LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK, LLP
600 South Avenue West, Westfield, New Jersey 07090
Telephone: (908) 654-5000 Facsimile: (908) 654-7866

PTO/SB/97 (12-97)

Approved for use through 9/30/00. OMB 0651-0031
Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

Certificate of Transmission Under 37 CFR 1.8

I hereby certify that this correspondence is being facsimile transmitted to the United States
Patent and Trademark Office

on March 22, 2004
Date

Shawn P. Foley
Signature

Shawn P. Foley
Typed or printed name of person signing Certificate

Note: Each paper must have its own certificate of transmission, or this certificate
must identify each submitted paper.

Certificate of Transmission under 37 CFR 1.8 (1 page)
International Preliminary Examination Report (5 pages).

PATENT COOPERATION TREATY

PCT

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

(PCT Article 36 and Rule 70)

Applicant's or agent's file reference ICON-002	FOR FURTHER ACTION See Notification of Transmittal of International Preliminary Examination Report (Form PCT/IPEA/416)	
International application No. PCT/US00/21461	International filing date (day/month/year) 07 AUGUST 2000	Priority date (day/month/year) 05 AUGUST 1999
International Patent Classification (IPC) or national classification and IPC Please See Supplemental Sheet.		
Applicant ICON GENETICS, INC.		

1. This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.
2. This REPORT consists of a total of 5 sheets.
- ☐ This report is also accompanied by ANNEXES, i.e., sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority. (see Rule 70.16 and Section 607 of the Administrative Instructions under the PCT).
- These annexes consist of a total of 2 sheets.

3. This report contains indications relating to the following items:

- I ☒ Basis of the report
- II ☐ Priority
- III ☐ Non-establishment of report with regard to novelty, inventive step or industrial applicability
- IV ☐ Lack of unity of invention
- V ☒ Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability, citations and explanations supporting such statement
- VI ☐ Certain documents cited
- VII ☐ Certain defects in the international application
- VIII ☒ Certain observations on the international application

Date of submission of the demand 27 FEBRUARY 2001	Date of completion of this report 19 SEPTEMBER 2001
Name and mailing address of the IPEA/US Commissioner of Patents and Trademarks Box PCT Washington, D.C. 20581	Authorized officer ASHWIN MEHTA
Facsimile No. (703) 305-3230	Telephone No. (703) 308-0196

Form PCT/IPEA/408 (cover sheet) (July 1998)*

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.

PCT/US00/21461

I. Basis of the report

1. With regard to the elements of the international application: *

☒ the international application as originally filed☒ the description:

pages 1-24, as originally filed
pages NONE, filed with the demand
pages NONE, filed with the letter of

☒ the claims:

pages 25-27, as originally filed
pages NONE, as amended (together with any statement) under Article 19
pages NONE, filed with the demand
pages NONE, filed with the letter of

☒ the drawings:

pages 1-4, as originally filed
pages NONE, filed with the demand
pages NONE, filed with the letter of

☒ the sequence listing part of the description:

pages NONE, as originally filed
pages NONE, filed with the demand
pages NONE, filed with the letter of

2. With regard to the language, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.
These elements were available or furnished to this Authority in the following language _____ which is:

- ☐ the language of a translation furnished for the purposes of international search (under Rule 23.1(b)).
☐ the language of publication of the international application (under Rule 48.3(b)).
☐ the language of the translation furnished for the purposes of international preliminary examination (under Rules 55.2 and/or 55.3).

3. With regard to any nucleotide and/or amino acid sequence disclosed in the international application, the international preliminary examination was carried out on the basis of the sequence listing:

- ☐ contained in the international application in printed form.
☐ filed together with the international application in computer readable form.
☐ furnished subsequently to this Authority in written form.
☐ furnished subsequently to this Authority in computer readable form.
☐ The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.
☐ The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

4. ☒ The amendments have resulted in the cancellation of:☒ the description, pages NONE☒ the claims, Nos. NONE☒ the drawings, sheets/fig. NONE5. ☐ This report has been drawn as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).**

* Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report since they do not contain amendments (Rules 70.16 and 70.17).

**Any replacement sheet containing such amendments must be referred to under item 1 and annexed to this report.

Form PCT/IPEA/409 (Box I) (July 1998) *

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.

PCT/US00/21481

V. Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement**1. statement****Novelty (N)**Claims 1-35 YESClaims NONE NO**Inventive Step (IS)**Claims 1-35 YESClaims NONE NO**Industrial Applicability (IA)**Claims 1-35 YESClaims NONE NO**2. citations and explanations (Rule 70.7)**

Claims 1-35 meet the criteria set out in PCT Article 35(2)-(4), because the prior art does not teach or fairly suggest a method of making a plant artificial chromosome comprising the claimed method steps. The claims have the industrial applicability of introducing advantageous non-native nucleic acid sequences to improve the quality of economically important food crops.

NEW CITATIONS

NONE

Form PCT/IPEA/409 (Box V) (July 1998)*

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.

PCT/US00/21461

VIII. Certain observations on the international application

The following observations on the clarity of the claims, description, and drawings or on the question whether the claims are fully supported by the description, are made:

Claims 1-17 are objected to under PCT Rule 66.2(a)(v) as lacking clarity under PCT Article 6 because the claims are indefinite for the following reason(s): line 1 of the claims indicates that the method is for making a plant artificial chromosome. However, the last step of claim 1 results in protoplasts.

Claims 1-36 are objected to under PCT Rule 66.2(a)(v) as lacking clarity under PCT Article 6 because the claims are indefinite for the following reason(s): The recitation "recombinant protoplasts" renders the claims indefinite. It is not clear what a "recombinant" protoplast is. For example, how does it differ from a non-recombinant protoplast?

During a telephone interview with Applicant's representative on September 10, 2001, it was discussed that an amendment, for example to claim 1, indicating in the preamble that the method is for making a plant artificial chromosome in a plant cell would obviate the former objection. It was also discussed that replacing "recombinant protoplasts" with "transgenic protoplasts" in the claims would obviate the latter objection.

Form PCT/IPEA/409 (Box VIII) (July 1995)*

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.

PCT/US00/21481

Supplemental Box

(To be used when the space in any of the preceding boxes is not sufficient)

Continuation of: Boxes I - VIII

Sheet 10

CLASSIFICATION:

The International Patent Classification (IPC) and/or the National classification are as listed below:

IPC(7): C12N 5/04, 15/05, 15/09, 15/81, 15/82, 15/87, 15/90; A01H 1/00, 5/00 and US Cl.: 435/320.1, 410, 419, 441, 468; 471; 800/278, 295, 298